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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,019	11/22/2000	Kazunori Ukigawa	Q61928	8508

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EXAMINER

DENNISON, JERRY B

ART UNIT PAPER NUMBER

2143

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/717,019

Applicant(s)

UKIGAWA ET AL.

Examiner

J. Bret Dennison

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11, 25, 28 and 29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11, 25, 28 and 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This Action is in response to Application Number 09/717,019 received on 26 July 2005.
2. Claims 11, 25, 28, and 29 are presented for examination.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 28 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
4. Claim 28 includes a program signal embodied in a carrier wave, which appears to be nothing more than a signal carrying instructions for execution not tangibly embodied in a manner so as to be executable and is thus non-statutory for failing to be in one of the categories of invention.
5. The Examiner recommends that Applicant consult the recently published "Interim Guidelines for Examination of Patent Applications for Patent Matter Eligibility"; especially Pages 50-57, available at:  
[www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101\\_20051026.pdf](http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf)  
<[http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101\\_20051026.pdf](http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf)>

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11, 25, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montero (U.S. 6,133,912) in view of "SQL Reference", IBM Corp., Copyright IBM Corp. 1993, 1997.

6. Regarding claims 11 and 29, Montero disclosed a server device that is connected to at least one client device through a network, said server device comprising:

schedule management means for managing relevance between classifications of information and transmission times of the information and relevance between information representing areas and time zones of the respective areas (Montero, col. 7, line 60 through col. 8, line 5);

request receiving means for receiving, from said client device, a request for transmission of information (Montero, col. 8, lines 10-20),

area determination means for determining in which area at least one client device having sent a request for transmission of information exists (Montero, col. 7, lines 40-60);

information providing means for referring to said schedule management means, and for selecting classified information corresponding to a present time in a time zone of

the area which is determined by said area determination means (Montero, col. 7, line 60 through col. 8, line 5), and

information sending means for sending, through the network, the information selected by said information providing means to a predetermined client device which has sent the request for transmission of the information (Montero, col. 7, line 60 through col. 8, line 5).

Montero also disclosed storing clicked event records of each client in a clicked event database, the records including details of what the client requested (Montero, col. 13, lines 35-45, 50-65), as well as keeping track of subscriber usage to develop a more precise profile on each subscriber (Montero, col. 14, lines 1-5).

Montero did not explicitly state wherein said information providing means further includes counting means for counting a number of client devices which have sent a request for transmission of information or a number of client devices to which said information sending means has sent requested information, according to the classifications of the information.

In a related art, IBM Corp. disclosed a specification of the well-known SQL database, which includes a COUNT function (Chapter 4.1.2, COUNT function), which returns the number of rows or values in a set of rows or values (see Chapter 4.1.2, COUNT function).

Montero suggests the use of databases but does not provide specific detail as to any specific database. Therefore, one of ordinary skill in the art would have been motivated to search the art for specifications of standard or well-known databases in

order to find standard database functions that may be used to keep track of subscriber usage and better target audiences.

IBM Corp. provides the well-known SQL database that includes standard functions of database programming.

Since Montero disclosed keeping track of all requests and interactions from subscribers, and keeping this information in a database, as well as using this information to better target their audience for advertisements (Montero, col. 14, lines 1-5), it would have been obvious to one of ordinary skill in the art at the time of the invention that being able to better target their audience by using the clicked reports would require statistics of the clicked reports from the database, and would therefore require the use of standard database functions in order to determine these statistics.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the standard database functions of IBM Corp, for the purpose of using the database records to come up with statistics about subscriber usage, for the benefit of keeping track of subscriber usage and being able to develop a more precise profile for subscribers, as well as enabling advertisers to better select their target audience for advertisements based on their clicked report records in the database (Montero, col. 14, lines 1-5).

Claims 25 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montero and IBM Corp as applied to claims 11 and 29 above, and further in view of Gupta et al. (U.S. Pub. No 2001/0020242).

7. Regarding claims 25 and 28, Montero and IBM Corp disclosed the limitations, substantially as claimed, as described in claims 11 and 29.

Claim 28 also includes the basic functions of a proxy server, wherein if the proxy server can handle the request, the proxy server serves the client, and if the proxy server is unable to handle the request, the proxy server sends the request to the server so the server handles the request.

Montero did not explicitly state the use of a proxy server to perform the same functionality of claim 11.

As disclosed by Gupta, proxy servers are used to carry out requests transmitted to it (i.e. from a client), keeping copies of fetched documents or information for some time so that they can be accessed more quickly in the future, speeding up access for commonly requested information (Gupta, page 1, paragraph 17). Therefore, it would have been within the level of one of ordinary skill in the art at the time of the invention to incorporate a proxy server, as disclosed by Gupta, into Montero in order to more efficiently deliver requested information by the clients of the system in order to speed up access to requested information (Gupta, page 1, paragraph 17), at the same time reducing the load on the network.

It would have also been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the proxy server of Gupta into the system of Montero to more efficiently collect user information from subscribers and utilize the information to

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conduct better targeted advertising (Montero, col. 8, lines 1-5 AND Gupta, paragraph 34).

### ***Response to Arguments***

Applicant's arguments with respect to claims 11, 25, 28, and 29 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments with respect to claims 25 and 28 include the failure of previously applied art to disclose the conditional operations: "reads out information corresponding to the request...when it is determined that the requested information is stored in said information storage means" and "sends the request to said server...when determined that the requested information is not stored in said information storage means."

As discussed in the above rejection, these conditional operations simply provide the functionality of a proxy server, which was well known in the art at the time the invention was made, as shown by Gupta et al. (U.S. Pub. 20010020242). As disclosed by Gupta, proxy servers are used to carry out requests transmitted to it (i.e. from a client), keeping copies of fetched documents or information for some time so that they can be accessed more quickly in the future, speeding up access for commonly requested information (Gupta, page 1, paragraph 17). Therefore, it would have been



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within the level of one of ordinary skill in the art at the time of the invention to incorporate a proxy server to perform the functionality of the invention in order to speed up access to requested information as well as to more efficiently conduct targeted advertising.

Applicant's arguments with respect to claims 11 and 29 include the failure of previously applied art to disclose the teachings of "counting means for counting a number of client devices which have sent a request for transmission of information or a number of client devices to which said information sending means has sent requested information, according to the classifications of the information."

As explained in the above rejection, Montero suggests the use of databases but does not provide specific detail as to any specific database. Therefore, one of ordinary skill in the art would have been motivated to search the art for specifications of standard or well-known databases in order to find standard database functions that may be used to keep track of subscriber usage and better target audiences.

IBM Corp. disclosed a specification of the well-known SQL database, which includes a COUNT function (Chapter 4.1.2, COUNT function), which returns the number of rows or values in a set of rows or values (see Chapter 4.1.2, COUNT function).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the standard database functions of IBM Corp, for the purpose of using the database records to come up with statistics about subscriber usage, for the benefit of keeping track of subscriber usage and being able to

develop a more precise profile for subscribers, as well as enabling advertisers to better select their target audience for advertisements based on their clicked report records in the database (Montero, col. 14, lines 1-5).

It is the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in manner, which distinguishes over the prior art.

Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response and reiterates the need for the Applicant to more clearly and distinctly define the claimed invention.

### ***Conclusion***

**Examiner's Note:** Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

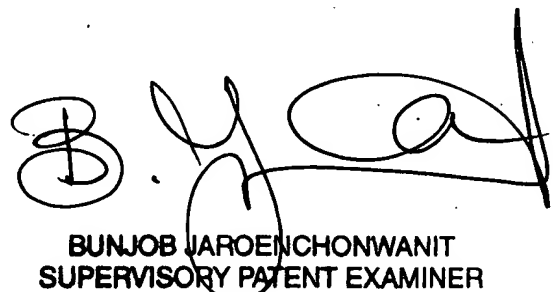
In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (571) 272-3910. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
J. B. D.  
Patent Examiner  
Art Unit 2143

  
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SUPERVISORY PATENT EXAMINER